# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/045,149 | 01/15/2002 | Edgar Circenis | 10016873-1 | 8859 |

| 7590 | 12/22/2005 |
|---|---|

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO  80527-2400

| EXAMINER |
|---|
| WU, RUTAO |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3639 | |

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | | Application No. | Applicant(s) |
|---|---|---|---|
| **Office Action Summary** | | 10/045,149 | CIRCENIS ET AL. |
| | | Examiner | Art Unit | |
| | | Rutao Wu | 3639 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *15 January 2002*.

2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1.      35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As per Claim 28, the claim recite a series of steps and are considered for the purpose of analysis un 35 U.S.C. 101 as reciting a series of steps.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result.  The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result".  The test for practical application as applied by the examiner involves the determination of the following factors"

        (a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner

        look at the claimed invention as a whole and compare any asserted utility with

the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

  i. the utility need not be expressly recited in the claims, rather it may be
inferred.

  ii. if the utility is not asserted in the written description, then it must be well
established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754
(Fed. Cir. 1994), the examiner will determine whether there is simply a
mathematical construct claimed, such as a disembodied data structure and
method of making it. If so, the claim involves no more than a manipulation of an
abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam*
the abstract idea of a data structure became capable of producing a useful result
when it was fixed in a tangible medium, which enabled its functionality to be
realized.

(c) "Concrete" – Another consideration is whether the invention produces a
"concrete" result. Usually, this question arises when a result cannot be assured.
An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack
of enablement rejection, because the invention cannot operate as intended
without undue experimentation.

The claim does not produce a useful output, thus it is not tangible. Also the claim does
not disclose any result of analyzing the metrics data, therefore produces no concrete

result. The claim, as currently recited, appear to be directed to nothing more than a

series of steps including receiving and analyzing metrics data without any useful,

concrete and tangible result and are therefore deemed to be non-statutory.


## Claim Rejections - 35 USC § 112

1.    The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.    Claims 11 and 12 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

3.    Claims 11 and 12 recites the limitation "the utility metering appliance" in line 1.

There is insufficient antecedent basis for this limitation in the claim.


## Claim Rejections - 35 USC § 102

4.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

5.      Claims 1-3, 7-19, 21-32 where claims 11 and 12 are presumed to be definite in

the interest of timely prosecution are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Pub No. 20020083003 to Halliday et al.

**Referring to claim 1:**

A software pay-per-use (PPU) system comprising:

A  computer having a PPU software product; and [0056]

A mechanism that collects metrics data from the PPU software product and

transmits the metrics data to a remote location. [0053]

**Referring to claim 2:**

The system of claim 1, wherein the mechanism includes:

A metering agent connected to the network, wherein the metering agent obtains

metrics data from the PPU software product. [0053]

**Referring to claim 3:**

The system of claim 2, wherein the metering agent includes a registry for

registering the PPU software product running on the computer.  [0056], [0077]

**Referring to claim 7:**

The system of claim 2, wherein the metering agent may be polled. [0053], [0056]

**Referring to claim 8:**

The system of claim 2, wherein the metering agent resides on the computer from

which the metering agent obtains the metrics data. [0056]

**Referring to claim 9:**

The system of claim 4, wherein the metering agent links to a metric gathering tool

for each PPU software product on the computer. [0053]

### Referring to claim 10:

The system of claim 1, wherein the mechanism includes

A utility metering appliance connected to the computer through a network,

wherein the utility metering appliance receives metrics data from the PPU software

product. [0051]

### Referring to claim 11:

The system of claim 1, wherein the utility metering appliance is located on a

standalone computer on the network. [0051], [0053]

### Referring to claim 12:

The system of claim 1, wherein the utility metering appliance runs as a process

on the computer that has the software PPU product. [0056]

### Referring to claim 13:

The system of claim 1, further comprising:

A usage collection and billing system at the remote location, wherein the usage

collection and billing system periodically receives the metrics data from the mechanism.

[0051], [0056]

### Referring to claim 14:

The system of claim 1, further comprising metrics gathering software for each

PPU software product running on the computer. [0062], [0085]

### Referring to claim 15:

The system of claim 1, further comprising:

A billing computer, wherein the billing computer receives metrics data from the

usage collection and billing system and provides a notification to customers of the

system based on the received metrics data. [0051], [0058]

### Referring to claim 16:

The system of claim 15, wherein the notification provided comprises a bill. [0058]

### Referring to claim 17:

The system of claim 1, further comprising a web portal that displays billing

information. [0053], [0064]

### Referring to claim 18:

The system of claim 1, further comprising a web portal that displays usage

information. [0053], [0064]

### Referring to claim 19:

The system of claim 1, wherein the metrics data includes cumulative metrics data

accumulated over a given time period. [0056]

### Referring to claim 21:

The system of claim 1, wherein the metrics data includes snapshot data. [0059]

### Referring to claim 22:

A method for gathering metrics data from at least one software pay-per-use

(PPU) product residing on at least one computer on a network comprising:

Collecting the metrics data from each PPU software product on at least one

computer; [0053], [0056]

Gathering the metrics data from each computer; and [0053]

Transmitting the metrics data to a usage collection and billing system. [0053],

[0056]

### Referring to claim 23:

The method of claim 22, further comprising

Registering each of the software products with a metric gathering tool

corresponding to the PPU software product in a registry on the at least one computer;

and [0056], [0077]

Executing the metric gathering tool for each PPU software product. [0056], [0062]

### Referring to claim 24:

The method of claim 22, further comprising the step of polling each at least one

computer to obtain data from the metric gathering tool. [0053], [0056]

### Referring to claim 25:

The method of claim 24, wherein the steps of executing the metric gathering tool

and collecting the metrics data is performed by a metering agent. [0056], [0077]

### Referring to claim 26:

The method of claim 22, wherein the step of polling the at least one computer

occurs at an interval specified by the at least one PPU software product. [0075]

### Referring to claim 27:

The method of claim 22, wherein gathering the metrics data further includes

gathering data from a plurality of PPU software products on the at least one computer.

[0085]

**Referring to claim 28:**

A method for auditing pay-per-use (PPU) software product metrics data

comprising:

Receiving metrics data for a PPU software product through a network

connection; and [0051]

Analyzing the metrics data for usage information. [0051]

**Referring to claim 29:**

The method of claim 28, further including:

Displaying the metrics data in a user-accessible form. [0053], [0064]

**Referring to claim 30:**

The method of claim 29, wherein the step of displaying metrics data further

includes limiting access to customers of the product. [0064]

**Referring to claim 31:**

The method of claim 28, further comprising

Providing a notification to a customer of the PPU software product, wherein the

notification informs the customer that payment is necessary based on the usage

information. [0058]

**Referring to claim 32:**

The method of claim 31, wherein the notification provided to the customer is a

bill. [0058]

*Claim Rejections - 35 USC § 103*

6.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.      Claims 4-6, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Halliday et al.

### As per claims 4, 5, 6:

Halliday et al does not expressly disclose

The system of claim 2, wherein the metering agent communicates using Simple

Network Management Protocol (SNMP), Web-Based Enterprise Management protocol

(WBEM), Desktop Management Interface (DMI).

Examiner submits however that it would have been obvious to one having

ordinary skill in the art at the time of the invention was made to include protocols such

as SNMP, WBEM and DMI for communication between the metering monitor, client

application, and metering server. The above noted protocols are all standards defined

by Distributed Management Task Force (DMTF) and Internet Engineering Task Force

(IETF) and therefore are well known in the field. Halliday et al provides specific

motivation by indicating that the library (of a client application) is responsible for

reporting, via an appropriate communication utility COMS, such usage to the metering

monitor [0062] and the metering server is connected to a set of metering monitors via a

communications link. [0051]

### Referring to claim 20:

Halliday et al does not expressly disclose

The system of claim 1, wherein the metrics data includes the number of

input/output (I/O) transactions in a given time period.

Examiner submits however that it would have been obvious to one having

ordinary skill in the art at the time of the invention was made to have the metrics data

include the number of input/output (I/O) transactions in a given period.  Halliday et al

disclosed in the application one embodiment of his invention as charging for features of

an application used.  Therefore, the metrics data collected are the feature pools of the

client application.  It is reasonable for Halliday et al's invention to collect number of

input/output (I/O) transactions in a given time period if the Pay Per Usage is based on

the number of I/O transactions.  Halliday et al also provides motivation by indicating that

the metrics may include but are not limited to: transmission times, local times, CPU

usage, memory usage and user information.


### Conclusion

8.      Examiner's Note: Examiner has cited particular columns and line numbers in the

references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well.  It is respectfully requested that the applicant, in preparing the

responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the examiner.

9.      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

    U.S. Pat No. 4,791,565 to Dunham et al.

    U.S. Pat No. 5,758,069 to Olsen.

    U.S. Pat No. 6,049,789 to Frison et al.

    U.S. Pub No. 20020022971 to Tanaka et al.

    U.S. Pub No. 20030083994 to Ramachandran et al.


Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rutao Wu whose telephone number is (571)272-3136.

The examiner can normally be reached on Mon-Fri 8-5.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on (571)272-6708.  The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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rw

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER